

Application No. 10/523775  
Amendment dated March 7, 2006  
Reply to Office Action of November 7, 2005

Docket No.: 09086-00219-US

### **REMARKS/ARGUMENTS**

The applicants respectfully request reconsideration in view of the amendment and the following remarks. The applicants have amended the claims to overcome the formal objections and rejections. Support for newly amended claim 1 can be found at page 3 line 30 of the original specification and in original claim 17, which has been incorporated. Support for newly added claim 21 can be found in the original claim 1 and the specification at page 3 lines 13-30. Support for newly added claim 22 can be found in the examples.

The applicant has added two claims and cancelled two claims. Therefore, no additional fee is required for the additional claims added to this application.

The Examiner objected to claims 1 and 18 because of informalities. The Examiner rejected claims 1, 3, 4, and 5 under 35 U.S.C. § 112 as being indefinite. The Examiner rejected claims 1-20 under 35 U.S.C. 102(a) as being anticipated by U.S. 6,320,003 ("Nishimura et al."). The Examiner rejected claims 1-20 under 35 U.S.C. 102(a) as being anticipated by U.S. 5,610,246 ("Buehler et al."). The Examiner rejected claims 1-20 under 35 U.S.C. 102(a) as being anticipated by JP 05-301921 ("Kataoka et al."). The applicants respectfully traverse these rejections.

#### **Claim Objections**

The Examiner objected to claims 1 and 18 because of informalities. Applicants have amended claims 1 and 18 as suggested by the Examiner. The applicants appreciate the Examiner's suggestions and have amended the claims accordingly. For the above reasons, this objection should be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 112**

The Examiner rejected claims 1, 3, 4, and 5 as being indefinite. Claim 1 has been amended to define "x". This amendment is supported at least by page 3 line 30 of the original specification.

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Claim 3 has been amended to remove "and radicals R having various possible meanings are combined with one another". This amendment is supported at least by the claim itself.

Claim 4 has been amended at line 4 with a dash between "O" and "i" to indicate that the "i" modifies "C<sub>3</sub>H<sub>7</sub>" and means "iso". Claim 4 has also been amended at lines 4 and 5 with dashes between "O" and "n" to indicate that the "n" modifies "C<sub>4</sub>H<sub>9</sub>" and "C<sub>3</sub>H<sub>7</sub>" and means "normal". This amendment is supported by general chemistry concepts.

Claim 5 has been amended to define "R". R is defined in the specification at page 4, lines 6-10. (OR) is as defined for R<sup>1</sup> or R<sup>2</sup>. For the above reasons, this rejection should be withdrawn.

#### Claims Rejections – 35 U.S.C. § 102

##### Nishimura et al.

The Examiner rejected claims 1-20 under 35 U.S.C. 102(a) as being anticipated by Nishimura et al. The applicant has two independent claims (claims 1 and 21).

##### Claim 1

Nishimura et al. discloses many different possibilities for an already solid catalyst component prepared by reacting a solution containing oxygen-containing organic compounds of magnesium with a zirconium compound.

Nishimura discloses at col. 5, line 38 through col. 6, line 2,

The silanes may, for example, be compounds represented by the general formula  $H_r Si_s R^4_t X^2_u$  wherein R<sup>4</sup> represents a group that can bond to the silicon, for example, a hydrocarbon group such as an alkyl group or an aryl group, having from 1 to 12 carbon atoms, or an alkoxy group, an aryloxy group or a fatty acid residue, having from 1 to 12 carbon atoms, and the plurality of R<sup>4</sup> may be the same or different; the plurality of X<sup>2</sup> may be the same or different and each represents a halogen i.e. F, Cl, Br or I; each of r, t and u is an integer of 0 or more, s is a natural number and r+t+u=2s or r+t+u=2s+2.

Specifically, they include, for example, silanhydrocarbons such as trimethylphenylsilane and allyltrimethylsilane, linear and cyclic organic

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silanes such as hexamethyldisilane and octaphenylcyclotetrasilane, organic silanes such as methylsilane, dimethylsilane and trimethylsilane, silicon halides such as silicon tetrachloride and silicon tetrabromide, alkyl and aryl halogenosilanes such as dimethyldichlorosilane, diethyldichlorosilane, n-butyltrichlorosilane, diphenyldichlorosilane, triethylfluorosilane and dimethyldibromosilane, alkoxysilanes such as trimethylmethoxysilane, dimethyldiethoxysilane, tetramethoxysilane, tetraethoxysilane, diphenyldiethoxysilane, triphenylethoxysilane, tetramethyldiethoxydisilane and dimethyltetraethoxydisilane, haloalkoxysilanes and halophenoxysilanes such as dichlorodiethoxysilane, dichlorodiphenylsilane and tribromoethoxysilane and silane compounds containing a fatty acid residue such as trimethylacetoxysilane, diethyldiacetoxysilane and ethyltriacetoxysilane.

The above organosilicon compounds may be used alone or two or more of them may be mixed or reacted for use. (emphasis added)

As described above, there are numerous possibilities disclosed in Nishimura. There are 30 examples disclosed in Nishimura and none of the examples use the applicant's claimed compound of the chemical formula



where M is an element of main group IV of the Periodic Table; R is halogen and x is an integer from 1-4. There are no examples in Nishimura that anticipate the applicant's claimed invention.

Furthermore, claim 1 of Nishimura requires at least one silane of the formula  $Si(OR^4)_4$  wherein  $R^4$  is a hydrocarbon group having 1 to 12 carbon atoms. Claim requires an Oxygen group which is not included in component (d) of the applicant's claim 1.

The Examiner must consider the reference as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless the prior art suggested the desirability of such modification (In re Gordon, 733 F.2d 900, 902,

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221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

#### Claim 21

New claim 21 has been drafted using the language "consisting of". This limits the catalyst claimed in claim 21 to the reaction product of four components namely magnesium alkoxide (component a) with a titanium compound (component b) and an organometallic compound (component c) together with an additional component (d) a compound of the chemical formula,  $M - R_x$ . Nishimura et al. requires at least five components and therefore does not anticipate nor render the applicant's new claim 21 obvious. For the above reasons, this rejection should be withdrawn.

#### Buehler et al.

The Examiner rejected claims 1-20 under 35 U.S.C. 102(a) as being anticipated Buehler et al.

#### Claim 1

Buehler et al. does not disclose nor teach the applicant's claimed (component c) a chlorine-containing organoaluminum compound. For the above reasons, this rejection should be withdrawn.

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### Claim 21

New claim 21 has been drafted using the language "consisting of". This limits the catalyst claimed in claim 21 to the reaction product of four components namely magnesium alkoxide (component a) with a titanium compound (component b) and an organometallic compound (component c) together with an additional component (d) a compound of the chemical formula,  $M - R_x$ . Buehler et al. requires at least five components and therefore does not anticipate nor render the applicants' new claim 21 obvious. For the above reasons, this rejection should be withdrawn.

### Kataoka et al.

The Examiner rejected claims 1-20 under 35 U.S.C. 102(a) as being anticipated by Kataoka et al.

### Claim 1

Kataoka et al. does not disclose nor teach the applicants' claimed (component c) a chlorine-containing organoaluminum compound. For the above reasons, this rejection should be withdrawn.

### Claim 21

New claim 21 has been drafted using the language "consisting of". This limits the catalyst claimed in claim 21 to the reaction product of four components namely magnesium alkoxide (component a) with a titanium compound (component b) and an organometallic compound (component c) together with an additional component (d) a compound of the chemical formula,  $M - R_x$ . Kataoka et al. requires that the catalyst is prepared in the presence of an aromatic dicarboxylic acid diester and therefore does not anticipate nor render the applicants' new claim 21 obvious. For the above reasons, this rejection should be withdrawn.

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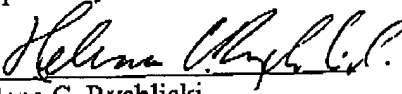
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Applicants note that the European Patent Office has allowed the counterpart to this application under the publication number 1539836.

A one month extension fee has been paid. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 C.F.R. 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants request that the Examiner telephone the undersigned at (302) 888-6281.

Respectfully submitted,

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